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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,752	03/30/2005	Katsuyu Wakabayashi	Q86974	1544

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

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06/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,752	Applicant(s) WAKABAYASHI ET AL.	
	Examiner Marc S. Zimmer	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05/03/07</u> . | 6) <input type="checkbox"/> Other: _____ |

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The rejections over Mita et al are hereby withdrawn because Applicant is, indeed, correct that the reference fails to disclose a compound adhering to the limitations of component (B).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 12, and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7-11, and 13 of copending Application No. 11/091509. Although the conflicting claims are not identical, they are not patentably distinct from each other.

First, the present Application claims the polymer component and carboxylic acid component broadly enough so as to fully embrace all permutations of the corresponding components of the '509 application. As to the molar ratio limitation of the present claim, the Examiner submits that the claim 1 of '509 contemplates both those embodiments where the molar ratio of (I) to (II) is greater than one, and those wherein it is less than one.

It is acknowledged, on the other hand, that the claims of the co-pending application are broader in their characterization of the metal carboxylate salt. Nevertheless, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). In this connection, the Examiner notes that in the first detailed description of the metal carboxylate on page 6 of the '509 Specification, it is said that a favored embodiment is that wherein the carbon adjacent to the carboxyl carbon is a quaternary carbon. In those instances, there would be significant overlap between the subject matter of the aforementioned claims.

As an aside, it has been observed that a non-statutory double-patenting rejection had been stated in the '509 application over the claims of this application and, further, that Applicant subsequently filed a terminal disclaimer where it was attempted to disclaim the terminal portions of any patents granted on various co-pending applications, including the present application, extending beyond the patent term of this application however Applicant misquoted the number of this application.

Claims 1, 7-9, and 17-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9 of copending Application No. 10/533309.

Insofar as the transitional phrase in present claim 1 is "comprising", it embraces any composition containing the stated materials, and also any other material. There is

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substantial overlap between the present and co-pending claims where the non-tin catalyst is a carboxylic acid having the structural features outlined in claim 9.

Claims 1, 11, 12, and 17-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6,-7, 10-11, and 13-14 of co-pending Application No. 10/568616.

The limitations of claims 1-3 of co-pending '616 overlap significantly with claim 1 of the present case. The same can be said of the limitations of co-pending claims 7, 10, and 11 when compared to instant claim 11 and of the limitations of claims 6, 13, and 14 when analyzed against instant claim 12.

Claims 1-6, 12, and 17-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 9-16 of co-pending Application No. 11/547026. Co-pending claim 6 of '026 further limits claim 1 of that application in a fashion that translates to there being notable overlap between the instant- and co-pending claims. Instant claims 2-6 and 12 contain much the same subject matter as do co-pending claims 2-5 and 9-12.

Claims 1, 4-6, 12, and 17-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5-7, 10, 12, 16, and 19 of co-pending Application No. 11/547030. The combined limitations of co-pending claims 1 and 3 and those of instant claim 1 recite inventions that overlap significantly in their scope. As before, the filler component and coupling agent of the co-pending claim are embraced by the present claims given

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Applicant's employment of the transitional phrase "comprising". Instant claims 4-6 and 12 contain much the same subject matter as do co-pending claims 6-7, 10, 12, and 19.

Claims 1-5 and 12-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7, 10-17 of co-pending Application No. 10/555416. The combined limitations of co-pending claims 1 and 7 and those of instant claim 1 recite inventions that overlap significantly in their scope. As before, the silicon compound of the co-pending claim are embraced by the present claims given Applicant's employment of the transitional phrase "comprising". Instant claims 2-5, 12, and 16 contain much the same subject matter as do co-pending claims 2-5 and 10-17.

Claims 1-6, 10, 12, and 17-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 9-11 of co-pending Application No. 11/547028. The combined limitations of instant claims 1 and 4 and those of co-pending claim 1 recite inventions that overlap significantly in their scope. As before, the acrylic polymer of the co-pending claim are embraced by the present claims given Applicant's employment of the transitional phrase "comprising". Instant claims 2, 3, 5-6, 10, and 12 contain much the same subject matter as do co-pending claims 2-4 and 9-11.

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

It must be acknowledged that none of the claims of the co-pending cases require the ratio of the acid component to the metal salt component to be less than 1 and, had Applicant's successfully illustrated unexpected results for this limitation, the Examiner would have been inclined to reconsider all of the aforementioned rejections. However, the only evidence that Applicant offers is a demonstration wherein, if the ratio of the acid to the salt is less than 1, the composition gets an adhesion rating of "B" meaning that there was observed a cohesive failure less than 60% of the time. Where said ratio is less than one, an adhesion rating of "A" was given meaning that cohesive failure was observed better than 60% of the time. The problems with this comparison are two-fold: (i) there is no clear reason why the 60% threshold is critical, and (ii) the meanings of the ratings "A" and "B" are so broad that one composition could get rating of "B" with 59% cohesive failure and another a rating of "A" with 61% cohesive failure. There is no clear demonstration of dramatic, and unexpected, improvement when this limitation is satisfied.

In an updated survey of the prior art, the Examiner encountered Wiirminghausen et al., U.S. Patent # 4,720,530. This reference describes a condensation curable composition that at least makes cursory mention of all of the claimed components. However, the Examiner does not believe that this reference represents a sound foundation for rejection because one would have to draw too much upon hindsight to reconstruct the claimed invention.

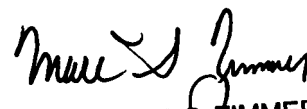
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 6, 2007


MARC S. ZIMMER
PRIMARY EXAMINER